

**REMARKS**

**I. Restriction Requirement**

The Examiner requires restriction between the following groups of claims:

Group I - Claims 42-87, drawn to a cosmetic composition;

Group II - Claims 88-98, drawn to a process for preparing a composition for making up keratin fibers;

Group III - Claims 99-113, drawn to a process for preparing a composition for making up keratin fibers;

Group IV - 114-115, drawn to a process for making up keratin fibers;

Group V - Claims 116-117, drawn to a process for making up keratin fibers;  
and

Group VI - Claims 118-119, drawn to a process for making up keratin fibers.

Applicants respectfully traverse the restriction requirement, as set forth above and on page 2 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 42-87, drawn to a process for preparing a composition for making up keratin fiber.

The Examiner states that the inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under Rule 13.2, they lack the same or corresponding special technical features. See Office Action at 2. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, make over the prior art so liked as to form a single general inventive concept. The Examiner views

that the instant composition recited in Claim 42 is obvious in view of the combination of US Patent Nos. 6,716,420 and 6,534,047. *Id.* at 2-3.

Applicant respectfully traverses the restriction on the basis that all of the present claims share the common technical relationship of a composition comprising “up to 20% by weight of water and/or of water-soluble solvent relative to the total weight of said composition; at least one wax in an amount of greater than 3% by weight relative to the total weight of said composition; and at least one volatile oil in an amount such that the total volatile oil content is less than or equal to the solids content of said composition .” See, e.g., claim 42. See M.P.E.P. § 1893.03. Accordingly, Groups I-VI should be rejoined.

Applicants submit that the Examiner’s restriction requirement is improper and should be withdrawn.

## **II. Election of Species**

The Examiner also requires the election of a single species (a wax).  
See Office Action at 3-4.

The election of species requirement is respectfully traversed. However, to be fully responsive, Applicant provisionally elects, with traverse, carnauba wax (which can be a micro-wax, small particles of 0.5 to 30 micrometers), with claim 62 reading on the elected species.

As with the restriction requirement discussed above, the Examiner merely asserts that “these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.” The


Office acknowledges that claims 42-53, 63-102, 104-105, and 107-119 are generic. See Office Action at 4. If the election of species requirement is maintained, Applicant expects the Office, upon allowance of the elected species, to continue to examine the full scope of the subject matter presently claimed to the extent necessary to determine the patentability thereof, as required by 35 U.S.C. § 121 and M.P.E.P. § 803.

### III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and examination of the claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Mark D. Sweet  
Reg. No. 41,469

Dated: June 15, 2009